

REMARKS:

Claims 1-38 remain in the application for consideration of the Examiner.

Claims 1-38 stand rejected under 35 U.S.C. § 112, first paragraph; claims 1-12 and 25-38 stand rejected under 35 U.S.C. § 112, second paragraph; and claims 1-38 stand rejected under 35 U.S.C. § 102.

Reconsideration and withdrawal of the outstanding rejections is respectfully requested in light of the following remarks.

REJECTIONS UNDER 35 U.S.C. § 112:

Rejections Under § 112, First Paragraph

The Office Action indicates that claims 1-38 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. However, it is respectfully submitted that the Office Action fails to establish a *prima facie* case of failure to comply with the enablement requirement for reasons discussed below.

The test for determining whether a claimed invention is properly enabled by the specification has been well-established: "Is the experimentation needed to practice the invention undue or unreasonable?"¹ The MPEP provides several factors for making an analysis of the undue experimentation question:

There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue." These factors include, but are not limited to:

- (A) The breadth of the claims;
- (B) The nature of the invention;
- (C) The state of the prior art;
- (D) The level of one of ordinary skill;
- (E) The level of predictability in the art;
- (F) The amount of direction provided by the inventor;

¹ MPEP 2164.01, citing *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916), and *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

- (G) The existence of working examples; and
- (H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure.²

The MPEP clearly states that each of these factors should be considered when making an analysis of undue experimentation:

It is improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors while ignoring one or more of the others. The examiner's analysis must consider all the evidence related to *each* of these factors, and any conclusion of nonenablement *must* be based on the evidence as a whole.³

Thus, based on the guidelines set forth in the MPEP, a proper analysis should be based on evidence related to each of the above factors.

The present Office Action, on the other hand, includes no such analysis. Rather, the Office Action presents the rejection as follows:

There are no written descriptions of embodiments, which describe the systems of claims 1, 37, 38, the method of claim 13 or the software of claim 25. The detailed description consists of a multiplicity of speculative phrases such as [various phrases included in the specification]. In addition to the lack of a specific embodiment, the specification consists of only speculative possibilities [another excerpt from the specification]. A discussion of enablement is provided in MPEP 2106 V B 2 below, which incorporates the decisions of [various cases].⁴

The above is then followed by a reproduction of MPEP 2106(V)(B)(2).

It is respectfully submitted that the rejection, as stated in the Office Action, fails to address any of the factors mandated by the MPEP and reproduced above. Instead, the Office Action merely reproduces portions of the specification and portions of the MPEP and concludes that the claims fail to comply with the enablement requirement. As such, the statement of the rejection is purely conclusory and provides none of the analysis required by the MPEP. For example, the MPEP requires that evidence related to each of

² MPEP 2164.01(a).

³ *Id.*, referencing *In re Wands*, 858 F.2d 731, 737, 740, 8 USPQ2d 1400, 1404, 1407 (Fed. Cir. 1988)(emphasis added).

the above factors *must* be considered; however, the Office Action fails to mention even one of these factors, and certainly provides no reasoning or analysis based on each of the factors.

It is also well-established that the Examiner bears the initial burden of providing the appropriate support for establishing a *prima facie* case in rejecting an application. As stated by the Federal Circuit, “[i]f examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent.”⁵ Since the Office Action fails to provide any of the requisite analysis for supporting this rejection, it is respectfully submitted that the rejection fails to properly establish a *prima facie* case of nonenablement, is improper, and should be withdrawn.

It is further noted that the allegations included in the statement of the rejection that there are no written descriptions of embodiments and that the specification consists of only speculative possibilities are respectfully traversed as being baseless and contrary to fact.

In light of the discussion above, it is respectfully requested that the rejection of claims 1-38 under 35 U.S.C. § 112 be reconsidered and withdrawn.

Rejections Under § 112, Second Paragraph

Claims 1-12, 25-36, and 38

Claims 1-12 and 25-38 stand rejected under 35 U.S.C. § 112, second paragraph.

The Office Action states that the claims in question are rejected “as being incomplete for omitting essential elements and structural cooperative relationships of elements, such omission amounting to a gap between the necessary elements and structural connections. See MPEP § 2172.01.”⁶ However, based on the specific reasoning provided in connection with claims 1, 25, and 38, Applicant’s are unclear as to why the claims in question are considered to omit essential elements and structural cooperative relationships of elements. For example, with respect to claim 1, the Office

⁴ Office Action, pp. 2-3.

⁵ *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

Action alleges that the claimed system “recites only one operable element ...[and] is akin to a black box which purports numerous capabilities without the technical support...”⁷ (the Office Action repeats these allegation for claims 25 and 38). Clarification as to how these allegations, if maintained, relate to an “omission amounting to a gap between the necessary elements and structural connections” is respectfully requested.

The allegation that claim 1 recites only one operable element is respectfully traversed as being contrary to fact. Even a cursory review of claim 1 would reveal that claim 1 recites more than the operable element noted in the Office Action. For example, claim 1 recites a collaboration service generator comprising software operable to perform certain claimed operations. Applicant respectfully submits that this argument applies to claim 38 as well.

The allegation that claim 1 recites an element that is “akin to a black box which purports numerous capabilities without technical support” is respectfully traversed as being baseless and contrary to fact. As would readily be appreciated by those skilled in the art, a computer-based system comprising software would certainly qualify as “technical support” for performing the claimed operations.

The Office Action also states that claim 1 recites an element “followed by a list of desired objectives, which this single element is purported to perform.” It is unclear exactly what this statement is intended to imply, but at the very least this statement is inaccurate as to the way it characterizes the claim. Claim 1 clearly claims more than a mere “list.” Claim 1 does not merely indicate that the operable element “purports to perform” anything; rather, claim 1 specifically recites that the claimed element “is operable to” perform certain operations.

In light of the discussion above, it is respectfully requested that the rejection of claims 1-12 and 25-38 under 35 U.S.C. § 112 be reconsidered and withdrawn.

⁶ Office Action, p. 5, ll. 6-8.

⁷ *Id.* at ll. 9-13.

Claim 37

Claim 37 stands rejected under 35 U.S.C. § 112, second paragraph. The Office Action alleges that claim 37 fails to particularly point out and distinctly claim the subject matter that is regarded as the invention. Specifically, the Office Action refers to the recitation of "means for providing a graphical user interface." The Office Action alleges that the claimed graphical user interface "would appear to be some hardware." However, this allegation is respectfully traversed. While hardware may be used for displaying a graphical user interface, the graphical user interface itself is not hardware. A graphical user interface can be provided by implementation of appropriate software. In light of the discussion and clarification above, it is respectfully requested that the rejection of claim 37 under 35 U.S.C. § 112 be reconsidered and withdrawn.

REJECTIONS UNDER 35 U.S.C. § 102(e):

Claims 1-38 stand rejected under 35 U.S.C. § 102(e) over U.S. Patent No. 6,862,585 to Planalp ("Planalp").

However, Planalp fails to disclose all of the limitations of claims 1-38, as discussed below. Therefore, Planalp cannot anticipate claims 1-38.

A claim is anticipated by a prior art reference only if the reference discloses or inherently describes every detail of the claim. According to the MPEP, "[a] claim is anticipated only if *each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."⁸ Also according to the MPEP, "[T]he identical invention must be shown in as *complete detail* as is contained in the ... claim."⁹

Claims 1-12

Claim 1 recites *inter alia*:

receive from the user, using the GUI, the solicited information regarding the design for the supply chain collaboration service in the predetermined sequence of design steps, the user being prevented from proceeding from a current design step to a subsequent design step until the particular information regarding the one or more particular aspects of the design for the supply chain collaboration service being solicited at the current design step is received from the user;

(Emphasis added.) Thus, claim 1 specifically recites (1) that information regarding the design for the supply chain collaboration service is solicited in a predetermined sequence of design steps, and (2) the user is prevented from proceeding from a current design step to a subsequent design step until the particular information regarding the one or more particular aspects of the design for the supply chain collaboration service being solicited at

⁸ MPEP 2131, citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), emphasis added.

⁹ MPEP 2131, citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989), emphasis added.

the current design step is received from the user. Claims 2-12 depend from claim 1 and therefore include the same limitations at least by reference.

Planalp fails to disclose many limitations of claim 1, including those pointed out above. The Office Action fails to provide any explanation as to who Planalp is considered to disclose the above limitations. Since the disclosure of Planalp fails to disclose all of the limitations of claim 1, Planalp cannot anticipate claim 1, or claims 2-12 which depend from claim 1.

Claims 13-38

With respect to independent claims 13, 25, 37, and 38, each of these claims includes limitations similar to those discussed above in connection with claim 1. Thus, the arguments presented above in connection with claim 1 apply equally to claims 13, 25, 37, and 38, as well as their dependent claims.

For the reasons set forth herein, the Applicants submit that claims 1-38 are not anticipated by Planalp. The Applicant further submits that claims 1-38 are in condition for allowance. Therefore, the Applicant respectfully requests that the rejection of claims 1-38 be reconsidered and that claims 1-38 be allowed.

THE LEGAL STANDARD FOR ANTICIPATION REJECTIONS UNDER 35 U.S.C. § 102:

The following sets forth the legal standards for "anticipation."

The events that can lead to anticipation can be divided into the following seven categories, all defined by statute:

1. Prior Knowledge: The invention was publicly known in the United States before the patentee invented it.

2. Prior Use: The invention was publicly used in the United States either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.

3. Prior Publication: The invention was described in a printed publication anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.

4. Prior Patent: The invention was patented in another patent anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his application.

5. On Sale: The invention was on sale in the United States more than one year before the patentee filed his application.

6. Prior Invention: The invention was invented by another person in the United States before the patentee invented it, and that other person did not abandon, suppress or conceal the invention.

7. Prior U.S. Patent: The invention was described in a patent granted on a patent application filed in the United States before the patentee made the invention.

Each of those seven events has its own particular requirements, but they all have the following requirements in common:

1. Anticipation must be shown by clear and convincing evidence.
2. If one prior art reference completely embodies the same process or product as any claim, the product or process of that claim is anticipated by the prior art, and that claim is invalid. To decide whether anticipation exists, one must consider each of the elements recited in the claim and determine whether all of them are found in the particular item alleged to be anticipating prior art.
3. There is no anticipation unless every one of those elements is found in a *single* prior publication, prior public use, prior invention, prior patent, prior knowledge or prior sale. One may not combine two or more items of prior art to make out an anticipation. One should, however, take into consideration, not only what is expressly disclosed or embodied in the particular item of prior art, but also what inherently occurred in its practice.

4. There cannot be an accidental or unrecognized anticipation. A prior duplication of the claimed invention that was accidental, or unrecognized, unappreciated, and incidental to some other purpose is not an invalidating anticipation.

Those four requirements must be kept in mind and applied to each kind of anticipation in issue. The following additional requirements apply to some categories of anticipation.

1. Prior Knowledge: An invention is anticipated if it was known by others in the United States before it was invented by the patentee. "Known," in this context, means known to the public. Private knowledge, secret knowledge or knowledge confined to a small, limited group is not necessarily an invalidating anticipation. Things that were known to the public only outside the United States are not invalidating anticipation.

2. Prior Use: An invention is anticipated if it was used by others before it was invented by the patentee, or more than one year before the patentee filed his patent application. "Use," in this context, means a public use.

3. Prior Publication: A patent is invalid if the invention defined by the claims was described in a printed publication before it was invented by the patentee or more than one year prior to the filing date of his application. For a publication to constitute an anticipation of an invention, it must be capable, when taken in conjunction with the knowledge of people of ordinary skill in the art, of placing the invention in the possession of the reader. The disclosure must be enabling and meaningful. In determining whether the disclosure is complete, enabling, and meaningful, one should take into account what would have been within the knowledge of a person of ordinary skill in the art at the time, and one may consider other publications that shed light on the knowledge such a person would have had.

4. Prior Patent: If the invention defined by the claims was patented in the United States or a foreign country, either before it was invented by the inventor or more than one year before the inventor filed his patent application, then the invention was anticipated. The effective date for this type of anticipation is the date on which two things

co-existed: (i) the owner of the referenced patent had the right to enforce that patent; and (ii) the reference patent was available to the public. What was "patented" in the reference patent is determined by what is defined by its claims, interpreted in the light of the general description.

5. On Sale: A patent is invalid if the invention claimed in it was on sale in the United States more than one year prior to the application filing date.

6. Prior Invention: If the invention defined by the claims was invented by another person, in the United States, before it was invented by the inventor, and that other person did not abandon, suppress, or conceal the invention, the invention lacks novelty. A prior invention, even if put in physical form and shown to produce the desired result, is not an invalidating anticipation unless some steps were taken to make it public. However, it is not necessary that the inventor had knowledge of that prior invention.

7. Prior U.S. Application: A patent is invalid for lack of novelty if the invention defined by the claims was described in a United States patent issued on a patent application filed by another person before the invention was made by the inventor. The effective date of a prior application for purposes of this issue is the date on which it was filed in the United States. Foreign-filed patent applications do not apply. If the issued United States patent claims the benefit of more than one United States application, its effective date as an anticipation is the filing date of the first United States application that discloses the invention claimed in that referenced patent.

Experimental Use Exception: The law recognizes that it is beneficial to permit the inventor the time and opportunity to develop his invention. As such there is an "experimental use" exception to the "public use" and "on sale" rules. Even though the invention was publicly used or on sale, more than one year prior to the application filing date, that does not invalidate the patent, provided the principal purpose was experimentation rather than commercial benefit. If the primary purpose was experimental, it does not matter that the public used the invention or that the inventor incidentally derived profit from it.

When a public use or sale is shown, the burden is on the inventor to come forward with evidence to support the experimental use exception. Only experimentation by or under the control of the inventor qualifies for this exception. Experimentation by a third party, for its own purposes, does not qualify for this exception. Once the invention leaves the inventor's control, its use is a public one, even if further experimentation takes place.

The experimentation must relate to the claimed features of the invention. And it must be for the purpose of technological improvement, not commercial exploitation. If any commercial exploitation does occur, it must be merely incidental to the primary purpose of experimentation. A test done primarily for marketing, and only incidentally for technological improvement, is a public use.

CONCLUSION:


In view of the foregoing remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

The undersigned hereby authorizes the Director to charge any fees that may be required, or credit any overpayments, to **Deposit Account No. 500777**. If an extension of time is necessary for allowing the Amendment to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777**.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

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